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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,933	06/22/2001	Robert Patrick Hof	24615201XX00	7691

7590

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 11/27/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/887,933

Applicant(s)

Hof et al

Examiner

Shailendra Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 22, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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### **DETAILED ACTION**

Claims 12-22 are pending in this application.

#### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Netherlands on 6/22/2000. It is noted, however, that applicant has not filed a certified copy of the priority based on the Netherlands application as required by 35 U.S.C. 119(b).

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 12-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hijiya et al(US 5,679,857).

Hijiya et al teach a process for racemizing an enantiomer enriched Schiff based derived from a primary amino acid amide by contacting the said enantiomer with a strong base in an organic solvent, wherein the strong base is chemically reactive with water. See column 4, lines 1-27. Note that the base in the art is same as claimed herein, and so is the solvent, see lines 3-5 for the base and line 23-24 of column 4, for the organic solvent.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hijiya et al.

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Instant claims are directed to a process of racemization of an enantiomer enriched Schiff based derived from primary amino acid amide by contacting the said enantiomer with a strong base in an organic solvent, wherein the strong base is reactive with water.

Hijiya et al teach similar process of racemization of a an enantiomer enriched Schiff base using alkaline alkoxide in an organic solvent, similar to as claimed herein. See column 2, line 5-7, column 4, lines 1-24. The difference between the reference and herein claimed process appears to be in the absolute amount of the base and the solvent.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use the process of Hijiya et al for the process of racemization if an enantiomer enriched Schiff based derived from the primary amino acid amide, because the prior art teaches the same process using metal alkoxide as base and hydrocarbon as an organic solvent for the process, with the reasonable expectation of achieving a racemized product, absent evidence to the contrary. Note the amount of organic solvent and base can be worked out under routine experimentation by the ordinary skill in the art.

US 4,847,412(Boesten et al), is cited to show the state of the art.

No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703) 308-4519. The examiner can

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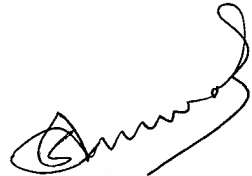
normally be reached on Monday to Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Johann Richter, can be reached on (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

S.Kumar

11/22/01



SHAIENDRA KUMAR  
PRIMARY EXAMINER  
GROUP 1200